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08/467,700 06/06/95 CHASE

L LII126A-US

EXAMINER

STORMER, R

ART UNIT

PAPER NUMBER

3

3102

DATE MAILED:

09/26/95

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31M1/0926

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-40 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 9-31 are allowed.
4. ☒ Claims 1, 8, and 32-40 are rejected.
5. ☒ Claims 2-7 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit: 3102

Claim Rejections - 35 USC § 112

1. Claims 32-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preambles of claims 32 and 38 set forth a wheel, but the claims recite the combination of a wheel and an attached overlay, thereby making it indefinite as to whether Applicant is claiming a wheel or a combination of a wheel and a cover.

Claim Rejections - 35 USC § 101

Double Patenting

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 32-40 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 32-40 of copending application Serial No. 08/479335. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Art Unit: 3102

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Derleth.

Lines 43+ in column 3 describe the temporary securing of the overlay to the wheel while the adhesive cures.

With respect to claim 8, the hubcap 21 and sleeve 18 assembly would form a fastener to help retain the overlay on the wheel.

6. Claims 32, 34, 35, 36, and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Post et al.

Note the embodiment shown in figures 8-10. The outer portion of the overlay contacts the rim of the wheel and also part of the bead seat, thereby spacing the overlay from the wheel and creating a gap for the adhesive.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3102

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8. Claim 33 is rejected under 35 U.S.C. § 103 as being unpatentable over Post et al.

Post et al meets all of the limitations of claim 32 as set forth in paragraph 5 above, but does not show an adhesive tape. However, to substitute an adhesive tape for the adhesives used by Post et al would have been obvious to one of ordinary skill in the art as a suitable alternative that might reduce the cost of assembly.

9. Claim 37 is rejected under 35 U.S.C. § 103 as being unpatentable over Post et al in view of Beam.

To employ a mechanical fastener to help position and/or secure the overlay on the wheel would have been obvious as taught by Beam in order to better secure the overlay to the wheel.

Art Unit: 3102

10. Claims 39 and 40 are rejected under 35 U.S.C. § 103 as being unpatentable over Post et al in view of Derleth.

As shown in figures 8-10, Post et al discloses a composite wheel and overlay in which the overlay is of a substantially uniform thickness and is secured to the wheel by an adhesive. The overlay does not have a decorative layer adhered to its outer surface.

Derleth teaches an overlay for a wheel that may have a chrome layer adhered to its outer surface. From this teaching it would have been obvious to apply a decorative layer to the outer surface of the overlay of Post et al in order to improve its appearance.

11. Claims 39 and 40 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Derleth.

Allowable Subject Matter

12. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 9-31 are allowable over the prior art of record.

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Art Unit: 3102

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Stormer whose telephone number is (703) 308-1113.

rds
September 15, 1995


RUSSELL D. STORMER
PRIMARY EXAMINER
ART UNIT 312
9/15/95